

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-30 are currently pending. Claims 1, 8, 17 and 23 are independent and are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. OBJECTIONS TO THE SPECIFICATION

The title of the invention has been amended herein to overcome the objection to the specification.

The specification has been amended herein to correct a typographical error on page 15, line 19. Applicants thank the Examiner for the telephone interview of July 19, 2006 wherein it was agreed that the Office Action inadvertently cited the error as being at page 2, line 19.

In view of the above amendments, Applicants respectfully request withdrawal of these objections to the specification.

III. REJECTIONS UNDER 35 U.S.C. §102

Claims 1, 3, 4, 17 and 19 were rejected under 35 U.S.C. §102 as allegedly anticipated by U.S. Patent No. 6,574,424 to Dimitri et al. (hereinafter, merely Dimitri).

In view of the amendments to the claims, Applicants respectfully traverse this rejection.

Independent claim 1, as amended, recites, *inter alia*:

“a receiver for receiving broadcast information and selecting a signal therefrom that includes commercial broadcast information having a supplied sequence;

...

a commercial detecting means for detecting the commercial broadcast information from said received broadcast information based on predetermined identification information contained in said broadcast information;” (emphases added)

As understood by the Applicants, Dimitri discloses a DVD recorded with data having a bit in each DVD memory sector header to indicate the type of information contained in the main data portion of the frame. A DVD drive examines the bit to determine whether to play a movie or to employ logic that allows the DVD drive to determine which included video clip to play instead. Col. 2, lines 10-17. Dimitri notes that DVD movies may have additional video programming installed on the disk. Col. 1, lines 43-48. Thus, the Dimitri device operates on data already stored on the DVD.

The data of Dimitri is stored with a “trigger bit” in the sector header to identify the sector contents. The data of Dimitri is read off of the DVD and handled based upon the value of the trigger bit. Col. 4, lines 21-26. That is, the apparatus of Dimitri does not receive broadcast information, determine the type of information and then record the received information with an identifier to the DVD. Dimitri requires that the information already be on the disk. Indeed, in

Dimitri there is no suggestion that information are broadcast, identified and then stored on the DVD.

In contrast, claim 1 recites, "receiving broadcast information and selecting a signal . . . storing . . . the broadcast information therefrom that includes commercial broadcast information . . . detecting the commercial broadcast information from said received broadcast information." The claim goes on to recite that the controller causes reproduction of the stored data so all of the commercial broadcast information is reproduced then sequentially followed by reproduction of the other broadcast information. Thus, in the present invention, broadcast information is received and stored. The present system identifies the broadcast commercial information when received, whereas in Dimitri the data are already identified and recorded on the DVD.

Claim 1 is patentable over Dimitri because that reference does not disclose each and every element recited in the claim. In particular, Dimitri does not disclose that the broadcast commercial data are received, identified and recorded to the DVD.

For reasons similar or somewhat similar to those described above with regard to independent claim 1, independent claims 8, 17 and 23 are also believed to be patentable.

Moreover, it is part of Applicants' invention to combine the feature of identifying broadcast commercial information when storing received broadcast information with altering the sequence when subsequently reproducing the stored information. This process of receiving, identifying, storing and altering the sequence on reproduction provides an advantage of having the commercial broadcast information reproduced sequentially followed by the other stored broadcast information. Publ. App. par. [0088].

It is the Applicants whom have recognized, and claim, the combination of features of reordering the reproduction of broadcast programming containing intermingled commercials received. The inventive device has the advantages to avoid content that ends up being reduced in interest to the user due to the insertion of commercial broadcasts in the middle, for example, of movies. The viewing becomes possible without interrupting the broadcast and therefore user dissatisfaction over commercial broadcasts can be reduced. Also, a different method of viewing of commercial broadcasts which are ordinarily boring is provided to the user and, at the same time, the commercial broadcasts are positively watched in comparison with the case where commercial broadcasts are unnaturally inserting not along with the flow of the broadcast contents. Therefore, the effect of the commercial broadcasts as advertisements can be raised. Publ. App. par. [0088].

IV. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 2 and 18 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Dimitri in view of U.S. Patent Application No. 2002/0019769 of Barritz et al. (hereinafter, merely "Barritz");

Claims 5-7 and 20-22 were rejected under 5 U.S.C. §103(a) as allegedly unpatentable over Dimitri and Official Notice;

Claims 8, 9, 23 and 24 were rejected under U.S.C. §103(a) as allegedly unpatentable over Dimitri in view Official Notice and inherency; and

Claims 10-16 and 25-30 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Dimitri in view of U.S. Patent No. 6,282,713 to Kitsukawa et al. (hereinafter, merely "Kitsukawa").

Applicants respectfully traverse these rejections for at least three reasons.

**A. DIMITRI, BARRITZ AND KITSUKAWA DO NOT DISCLOSE
EVERY ELEMENT RECITED IN CLAIMS 8, 9, 23 AND 24**

As discussed above, Dimitri does not disclose each and every element recited in the amended claims. Barritz, Kitsukawa, inherency and Office Notice do not add the element missing from Dimitri. Thus, claims 2, 5-16, 18 and 20-30 are patentable for at least the same reasons as 1, 3, 4, 17 and 19.

Further, claim 8, as amended, recites, *inter alia*:

“... generating image information corresponding to said detected commercial broadcast information and combining the same with the reproduced image of said series of broadcast information, and making said reproducing means reproduce the combined image information, and, when said commercial designation signal is input, reading the commercial broadcast information designated by the related commercial designation signal from said storing means and making said reproducing means reproduce the commercial broadcast information, and, in the following reproduction of said series of broadcast information, reproducing the broadcast information while not reproducing, but skipping over the commercial broadcast information which has been already reproduced.” (emphasis added)

In the present application, claim 8 recites the additional feature of reproducing, “the commercial broadcast information, and, in the following reproduction of said series of broadcast information, reproducing the broadcast information while not reproducing, but skipping over the commercial broadcast information which has been already reproduced.” Thus, commercial broadcast information is detected in the received broadcast information and is designated with a signal when the received commercial broadcast information is stored. At the time of reproduction, the commercial broadcast information is sequentially combined with the broadcast information. The claimed method reproduces the sequence of the commercial broadcast

information followed by the broadcast information. However, when the broadcast information is being reproduced, the method skips over the commercial broadcast information, thus avoiding duplication of the commercial broadcast information.

The above feature is not disclosed in the Dimitri reference. Thus, claim 8 is patentable over Dimitri for this reason in addition to the reasons discussed above in relation to claim 1.

**B. REJECTION OF CLAIMS 8, 9, 23 AND 24
IMPROPERLY BASED ON INHERENCY**

From MPEP 2112(IV): "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic . . . To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Office Action cites Dimitri for the claim 8 element, "a commercial detecting means for detecting the commercial broadcast information from said received broadcast information based on predetermined identification information contained in said received broadcast information." The Office Action points to Dimitri col. 4, lines 50-65 and states, "it is inherent

that there is a commercial detector in order to determine when and what commercial to playback.” This is a misinterpretation of the operation of Dimitri.

Dimitri does not inherently imply a commercial detecting means. As discussed above, in Dimitri a DVD includes data having a “trigger-bit” in each DVD memory sector header to indicate the type of information contained in the main data portion of the frame. Col. 2, lines 10-17. The “trigger-bit” indicates whether the data in the sector contains either image data, arguments for microcode functions or microcode itself. Col. 4, lines 20-25. In the lines preceding the location cited (col. 4, lines 50-65) in the Office Action, Dimitri discloses reading the “trigger-bit” to determine what is in the sector (*i.e.*, image data, arguments for microcode functions or microcode itself).

Thus, at the cited location col. 4, lines 50-65, Dimitri is disclosing the actions taken when the “trigger-bit” has certain values as microcode argument values. Dimitri states, “[the process] illustrates reading argument values stored on the DVD, where Nzero is the first track containing a commercial, Ntotal is the total number of tracks containing commercials and Nvideo is the first track of a movie.” The DVD happens to contain commercial data in some instances, which is identified by running microcode with certain argument values from the sector heading. There is no suggestion that Dimitri must inherently have “a commercial detecting means,” a physical device recited in claim 8 of the present application, which detects broadcast commercial information from within received broadcast information. Indeed, there is no technical reason that Dimitri inherently must have a commercial detecting means and, therefore, the structure illuminated in the specification. The Office Action is asserting that there is no other way for Dimitri to achieve its purpose other than with Applicants commercial detecting means.

Inherency would require a commercial detecting means as discussed in Applicants' specification necessarily be part of the Dimitri invention. Applicants contend this is just not the case.

The Office Action fails to "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" (emphasis added). MPEP 2112.

Claims 8, 9, 23 and 24 are patentable over Dimitri because that reference does not teach each and every element recited in the claims. Dimitri does not necessarily or inherently require the structure as recited in the present application.

C. **REJECTION OF CLAIMS 8, 9, 23 AND 24
NOT PROPERLY OFFICIALLY NOTICED OR
NOT PROPERLY BASED UPON COMMON KNOWLEDGE**

From the MPEP 2144.03(E): "Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. *See, for example, In re Zurko*, 258 F.3d 1379, 1386; *In re Ahlert*, 424 F.2d 1088, 1092.

Regarding claim 8, Applicants contend that it is not of notorious character, as asserted in the Office Action, that the feature, "in the following reproduction of said series of broadcast information, reproducing the broadcast information while not reproducing, but skipping over the commercial broadcast information which has been already reproduced" as recited in the claim

can be Officially Noticed. Thus, Applicants challenge the assertion of common knowledge as asserted in the Office Action.

The Office Action states, “Official Notice is taken that the player would not keep replaying the same commercials because each sponsor paid to have their commercial in that time slot and therefore each commercial must be played in order to please each sponsor.” Applicants contend this reason is less “Official Notice” and more akin to mere conjecture, relying upon supposition. As such, the Office Action reasoning does more than “serve only to ‘fill in the gaps’ in an insubstantial manner.” MPEP 2144.

From the MPEP 2144.03, “[a]s noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute.” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).”

The recited features of claim 8, 9, 23 and 24 can not be considered capable of such “instant and unquestionable demonstration as to defy dispute.” This feature is neither “basic knowledge” nor “common sense.” *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002) (“Deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense.’”). Applicants contend that claim 7 recites a substantive feature that can not be overcome with Official Notice.

Applicant does not concede that the Official Notice is properly noticed and respectfully requests an appropriate citation for the element, “in the following reproduction of said series of broadcast information, reproducing the broadcast information while not reproducing, but skipping over the commercial broadcast information which has been already reproduced.”

CONCLUSION

Claims 1-30 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: 

Paul A. Levy
Reg. No. 45,748
(212) 588-0800